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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/552,131
Filing Date: April 19, 2000
Appellant(s): MELKOTE ET AL.

BENJAMIN C. STASA
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/01/2008 appealing from the Office
action mailed 07/08/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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2002/0095368 A1

Pub. No.: US ANECKI et al. 01-2006

2006/0010377 A1

Pub. No.: US TRAN 12-2001

2001/0049797 A1

Pub No.: US MATHEWS et al. 08-2006

2006/0190443 A1

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16, 17-20, 22, 23-36 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over TRAN (Pub. No.: US 2002/0095368 A1, Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000) in view of Anecki et al. (Pub. No.: US 2006/0010377 A1, hereinafter as ANECKI) (provisional application No.: 60/187,444, filed on Mar. 7, 2000) and further in view of TRAN (Pub. No.: US 2001/0049707 A1, hereinafter as TRAN707, Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000).

With respect to claim 1, TRAN teaches a method of forming an invention disclosure (forming legal document on Web-based system for Intellectual Property (IP): abstract, para 0016-0017 and 0020-0022), comprises the step of:

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (via web-based interface, the user enters information/data on on-line form and it is stored on a database stored on the server as shown in fig. 1: para 0014-0015 and abstract; the users here are IP specialists such as attorneys and inventors on requests: see para 0008 and 0011).

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information and allowing online access to the status of invention disclosure, said status comprising said invention disclosure is in a reviewing and application filing process as claimed.

However, ANECKI teaches reviewing legal document and access and approve status of a legal document (para 0046-0047; also see para 0052-0053 and 0059). Also, users (such as customers or as inventors, figs. 1, 3b and 5, item 1000) may access and control the legal document creation and approval process (page 3, paragraphs 0046, lines 1-5 and 0047, lines 2-6). Legal document is a

kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer as inventor over the Internet (page 3, para 0047, lines 1-6).

Therefore, based on TRAN in view of ANECKI, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011). Combination of TRAN and ANECKI do not teach forming an invention disclosure online by entering a plurality of selected information portions into a web-based system.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (para 0041 and 0044).

Therefore, based on TRAN in view of ANECKI, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's para 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's para 0002 and 0015).

With respect to claim 2, TRAN teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (identification information to the user and searching information: para 0026 and 0029).

With respect to claims 3 and 8, TRAN teaches a method as discussed in claim 1.

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach comprising the step of prompting the user for classification information classifying the invention disclosure into a technology area as claimed.

However, ANECKI teaches filtering information via a "Filter" button as shown on fig. 21 (para 0122-0123 and 0128); and when the forms popped up or

prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, para 0122-0123 and 0108).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 4-7, TRAN teaches a method as discussed in claim 1. Also, TRAN teaches evaluation process for an IP asset (para 0042-0043).

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach notifying an evaluator in response to the classification information prompting an evaluation from the evaluator, notifying an evaluator comprises generating an e-mail; providing hyperlink to the disclosure in

the e-mail; scheduling an evaluation meeting and ranking the disclosure as claimed.

However, ANECKI teaches evaluating the information and approving the legal document (section 0092); generating email and hyperlink (para 0009, 0041, 0051-0052 and 0062, fig. 8); scheduling and ranking (para 0002 and 0122-0123 and 0128).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 8-9, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (para 0009-0010 and fig. 1).

With respect to claims 10-12, TRAN teaches a method as discussed in claim 1.

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, ANECKI teaches web server as shown in figs. 8 and 10 (para 0095 and 0101-0102) and generating email and hyperlink (para 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 13-14, TRAN teaches a method as discussed in claim 1. Also, TRAN teaches evaluation process for an IP asset (para 0042-0043).

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, ANECKI teaches email and hyperlink (para 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document

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preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 15 and 16, TRAN teaches prompting users for a password and scanning said paper submission into the database (entering user name and password and submitting the form storing in the patent database: para 0005, 0007, 0017, 0024 and 0026).

With respect to claim 17, TRAN teaches an invention disclosed system (fig. 1), comprising:

- at least one user computer accessible by a plurality of inventors associated with a single invention disclosure (fig. 1);

- a server coupled to said at least one user computer (fig. 1);

- a database coupled to the server (fig. 1);

- and said server providing user screen to said least one user computer to prompt said inventors to provide a plurality of disclosure information to said server, after storing the plurality of disclosure information within said database (fig. 1, user interface is web-based user interface and system prompts for user to enter information to the system: para 0014, 0016-0018).

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach prompting said plurality of inventors for invention disclosure approval as claimed.

However, ANECKI teaches reviewing legal document and access and approve status of a legal document (para 0046-0047; also see para 0052-0053 and 0059); users may access and control the legal document creation and approval process (page 3, para 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, para 0047, lines 1-6) and when the forms popped up or prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, para 0122-0123 and 0108).

Therefore, based on TRAN in view of ANECKI, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011). Combination of TRAN and ANECKI do not teach receiving the plurality of disclosure information from said

users, storing information in said database after each of the plurality of disclosure information is entered, allowing access to said disclosure.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (para 0041 and 0044).

Therefore, based on TRAN in view of ANECKI, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's para 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's para 0002 and 0015).

With respect to claim 18, TRAN teaches comprising a directory system coupled to said server whereby upon proving identification information to sever said server retrieves user information from the directory system in response to the identification information (identification information to the user and searching information and user has to sign-in/sign-off the system: para 0016-0018 and 0026 and 0029).

With respect to claim 19, TRAN teaches wherein said server comprises a web server (a web server: fig. 8 and 10, para 0095 and 0101-0102).

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With respect to claim 20, TRAN teaches wherein said user computer comprises a web browser for accessing said server (using a browser for viewing: para 0008 and 0027).

With respect to claim 22, TRAN teaches wherein server comprises a web single login to access said invention disclosure (sign-on and password: para 0016 and 0023-0024).

With respect to claim 23, TRAN teaches a method of forming an invention disclosure (forming legal document on Web-based system for Intellectual Property (IP): abstract, para 0016-0017 and 0020-0022) comprising:

after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location (via web-based interface, the user enters information/data on on-line form and it is stored on a database stored on the server as shown in fig. 1: para 0014-0015 and abstract) and

prompting the user for classification information, which refers to a technology area (the techniques support real time and interactive entries via using the Internet, receiving real-time feedback, submitting an offer using an interactive form and promptings: para 0009-0010, 0017-0018, 0025 and 0034). The information such as technical of invention, range of technology, cutting edge of high technology, and classification or categorization information is provided via the system's interactive actions (para 0019, 0022, 0041 and 0043).

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP

document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach allowing access to various users to access the information; notifying an evaluator in response to the classification information and prompting an evaluation from evaluator as claimed.

However, ANECKI teaches reviewing legal document and access and approve status of a legal document (para 0046-0047; also see para 0052-0053 and 0059); the legal document requestor or customer as inventor reviews the notification and then selects a transmission method. The requestor is notified by sending a confirmation via e-mail messages and the requestor is notified by a confirmation of the availability of the amendment (para 0009 and 0051-0052) and evaluating the information and approving the legal document (evaluates the request and approves the legal document by sending an approval to the legal document server. The legal document server updates the legal document in progress and puts the updated status of the legal document in progress into a database maintained by a legal document database server) (para 0092); and users may access and control the legal document creation and approval process (page 3, para 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, para 0047, lines 1-6).

Therefore, based on TRAN in view of ANECKI, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011). Combination of TRAN and ANECKI do not teach forming an invention disclosure online by entering a plurality of selected information portions into a web-based system.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (para 0041 and 0044).

Therefore, based on TRAN in view of ANECKI, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's para 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and

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navigate the information needed to procure IP assets (TRAN707's para 0002 and 0015).

With respect to claim 24, TRAN teaches wherein said step of forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (identification information to the user and searching information: para 0026 and 0029).

With respect to claims 25-27, TRAN teaches a method as discussed in claim 23.

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach notifying an evaluator comprises generating an e-mail; providing hyperlink to the disclosure in the e-mail; scheduling an evaluation meeting and ranking the disclosure as claimed.

However, ANECKI teaches generating email and hyperlink (para 0009, 0041, 0051-0052 and 0062, fig. 8); scheduling and ranking (para 0002 and 0122-0123 and 0128).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it

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motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 28-29, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (para 0009-0010 and fig. 1).

With respect to claims 30-32, TRAN teaches a method as discussed in claim 23.

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, ANECKI teaches web server as shown in figs. 8 and 10 (para 0095 and 0101-0102) and generating email and hyperlink (para 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 33-34, TRAN teaches a method as discussed in claim 23. Also, TRAN teaches evaluation process for an IP asset (para 0042-0043).

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach wherein said central location comprises a database coupled to a web server, identifying co-authors; notifying co-authors of

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a disclosure with their name associated therewith in the system and notifying comprises the step of generating an E-mail having a hyperlink therein as claimed.

However, ANECKI teaches email and hyperlink (para 0009, 0041, 0051-0052 and 0062, fig. 8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 35 and 36, TRAN teaches prompting users for a password and scanning said paper submission into the database (entering user name and password and submitting the form storing in the patent database: para 0005, 0007, 0017, 0024 and 0026).

With respect to claim 37, TRAN teaches a method of submitting documents (submitting IP document: para 0017), comprising:

entering identification information into a user computer (sign-on with user name/user ID and password: para 0016 and 0024-0026); and

coupling said user information with said invention disclosure (user information: para 0016, 0023-0024 and 0034; the server supports an IP portal that provides a single point of integration, access and navigation thru the systems. The user interface allows a user to login or logoff the system with his/her own password that accepted by the system and some technical information (technical of the invention and categorization): page 2, 0016, page 3, 0019 and page 6, 0043) and user's profile containing user information (page 2, 0010, lines 5-20 and page 4, 0024-0025).

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach retrieving user information from a directory system in response to said identification information, storing the disclosure in a computer database, performing a search is at least the state of art associated with said invention disclosure and wherein said search is at least partially directed by at least one inventor of said invention disclosure as claimed.

However, ANECKI teaches searching/retrieving legal documents (para 0040 and 0060), storing legal document in the legal document database (section 0050) and performing search the legal documents or prior arts, search form and result list (figs 22-23). The users or customer as inventors entering the desired

or requested information to the search entry form (see fig. 22) and the result list is shown in the fig. 23 (para 0122-0126 and 0120; also, see fig. 1 and section 0041).

Therefore, based on TRAN in view of ANECKI, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application (ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011). Combination of TRAN and ANECKI do not teach entering disclosure information to create an invention disclosure.

However, TRAN707 teaches generating a patent application or intellectual property or invention disclosure over internet or on-line via prompting from which a user enable to enter an invention disclosure and assist the user in discerning validity and patentability of subject matter (para 0041 and 0044).

Therefore, based on TRAN in view of ANECKI, and further in view of TRAN707, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of TRAN707 to the

system of TRAN to generate an invention disclosure online from the user as disclosed (TRAN707's para 0041), into the system of TRAN for the purpose of procuring intellectual property assets, thereby, enabling user to locate and navigate the information needed to procure IP assets (TRAN707's para 0002 and 0015).

With respect to claims 38-39, TRAN teaches a method as discussed in claim 37.

TRAN teaches on-line form via web-based interface for users, who are IP specialist such as attorneys and inventors to enter information related to IP document or application and store those information or data into a database in the central location of a web server of a web-based system as shown in fig. 1. TRAN does not explicitly teach prompting the user for classification information, notifying an evaluator in response to the classification information prompting an evaluation from the evaluator as claimed.

However, ANECKI teaches filtering information via a "Filter" button as shown on fig. 21 (para 0122-0123 and 0128) and evaluating the information and approving the legal document (section 0092).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of ANECKI. One having ordinary skill in the art would have found it motivated to utilize the use of a web-based automated creating and tracking legal document or invention disclosure system for keeping track of status of legal document or invention disclosure, reviewing and filing a patent application

(ANECKI's abstract and para 0047, and 0052-0053), into the system of TRAN for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing (ANECKI's para 0001 and 0010-0011).

With respect to claims 40-41, TRAN teaches notifying a patent staff in response to the classification information and prompting a patentability review from the patent staff person (para 0009-0010 and fig. 1).

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over TRAN (Pub. No.: US 2002/0095368 A1, Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000) in view of Anecki et al. (Pub. No.: US 2006/0010377 A1, hereinafter as ANECKI) (provisional application No.: 60/187,444, filed on Mar. 7, 2000) and further in view of TRAN (Pub. No.: US 2001/0049707 A1, hereinafter as TRAN707, Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000) and Mathews et al. (Pub. No.: US 2006/0190443 A1, hereinafter as MATHEWS, continuation of application No.: 09/539,500, filed on Mar. 30, 2000).

With respect to claim 21, TRAN view of ANECKI discloses an invention disclosure system as discussed in claim 17.

TRAN and ANECKI disclose substantially the invention as claimed.

TRAN and ANECKI do not explicitly teach comprises a computer aided design (CAD) file view coupled to said web browser as claimed.

However, MATHEWS teaches using CAD and CAD facility for viewer (section 0054; also see para 0051-0054).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify TRAN, ANECKI and TRAN707's system to include CAD facility for viewer as taught by MATHEWS in order for providing a way to view the legal document or IP. The motivation being for providing access to drawing information and distribution of design drawing data, thereby, viewing the information or files over the Internet using a browser (Mathews's section 0007 and 0020).

(10) Response to Argument

Argument:

Appellant argued that, "Anecki does not disclose allowing on-line access ... Anecki does not discuss invention disclosures or inventors." (page 3, 3rd paragraph).

Response:

In response to Appellant's arguments, Examiner respectfully disagrees as ANECKI teaches legal document server or database as Intellectual Property (IP) such as patents or patent applications including invention disclosures (para 0043, lines 1-3; also see fig. 1, para 0040-0041). And the users such as customer, who is inventors (figs. 1, 3b and 5, item 1000) and these users are accessing the legal

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document over the Internet or on-line access to transmit document requests to the document server (para 0056).

Argument:

Appellant argued that, "Anecki does not disclose allowing access disclosure ... for disclosure approval." (page 3, 4th paragraph).

Response:

In response to Appellant's arguments, Examiner respectfully disagrees as ANECKI teaches allowing users or inventors to access legal documents as invention disclosures in the patents or patent applications (para 0043, lines 1-3; also see fig. 3b, item 1208, para 0040-0041). The users such as customer, who is inventors (figs. 1, 3b and 5, item 1000). Also, ANECKI teaches reviewing legal document and access and approve status of a legal document. The approval status document includes the status of the approvals received for generation of a legal document. The legal document server provides the approval status document to the requestor as a Web page via the Internet (para 0008, 0046-0047; also see para 0052-0053 and 0059; also see para 0079 and 0091-0092 and fig. 7); users may access and control the legal document creation and approval process (page 3, para 0046, lines 1-5 and 0047, lines 2-6). Legal document is a kind of IP document, from which the user granted access or allowed access and controlled its status such as approval of status of a legal document; tracking of legal documents once the legal documents are issued to the customer or client or inventor (page 3, para 0047, lines 1-6) and when the

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forms popped up or prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, para 0122-0123 and 0108).

Appellant argued that, "Tran does not disclose prompting the use for classification information, which refers to a technology area." (page 3, 5th paragraph and page 9, the 3rd paragraph).

Response:

In response to Appellant's arguments, Examiner respectfully disagrees as TRAN teaches the techniques support real time and interactive entries via using the Internet, receiving real-time feedback, submitting an offer using an interactive form and promptings (para 0009-0010, 0017-0018, 0025 and 0034). The information such as technical of invention, range of technology, cutting edge of high technology, and classification or categorization information is provided via the system's interactive actions (para 0019, 0022, 0041 and 0043). Also, ANECKI teaches when the forms popped up or prompted to the users, the receiver may select the filter button to enter the field or data into the field with technical data (page 9, para 0122-0123 and 0108).

Argument:

Appellant argued that, "Anecki does not disclose allowing access to various users to access information, notifying an evaluator ...from the evaluator."

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(page 6 and 7: the last 2 lines on the page 6 and the first three lines on the page 7 and page 10, the 7th paragraph).

Response:

In response to Appellant's arguments, Examiner respectfully disagrees as ANECKI teaches the legal document requestor or customer as inventor reviews the notification and then selects a transmission method. The requestor is notified by sending a confirmation via e-mail messages and the requestor is notified by a confirmation of the availability of the amendment (para 0009 and 0051-0052) and evaluating the information and approving the legal document (evaluates the request and approves the legal document by sending an approval to the legal document server. The legal document server updates the legal document in progress and puts the updated status of the legal document in progress into a database maintained by a legal document database server) (para 0092).

Argument:

Appellant argued that, "Anecki does not disclose performing a search ... wherein said search is at least partial directed by at least one inventor of said inventor disclosure." (page 7, 2nd paragraph).

Response:

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In response to Appellant's arguments, Examiner respectfully disagrees as ANECKI teaches search form and result list (figs 22-23). The users or customer as inventors entering the desired or requested information to the search entry form (see fig. 22) and the result list is shown in the fig. 23 (para 0122-0126; also see 0120. see fig. 1 and section 004).

Argument:

Appellant argued that, "Examiner has failed to establish a prima facie case of obviousness." (pages 7-9, staring 2nd paragraph on page 7 thru page 8 and ending the first 2 lines of page 9).

Response:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, TRAN (Pub. No.: US 2002/0095368 A1, Non-provisional of provisional application No. 60/185,644, filed on Feb. 29, 2000) and Anecki et al. (Pub. No.: US 2006/0010377 A1, hereinafter as ANECKI) (provisional application No.: 60/187,444, filed on Mar. 7, 2000) are from the same

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field of endeavor and both are directed to providing the users (such as inventors) of the Internet network to access the legal document or Intellectual Property or patents or patent applications. One having ordinary skill in the art would have found it motivated to combine the teachings of TRAN and ANECKI because that would provide TRAN's system the enhanced capability of increasing the efficiency of document preparation using computerized processing, therefore, enabling the user to track the status of pending and issued legal documents or patent applications. Moreover, the examiner kindly submits that the applicants misread the applicable references used in the last office action. However, when read and analyzed in light the specification, the invention as claimed does not support applicant's assertions. Actually, applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejections. Additionally, it is important to note that the examiner interpretation of the claims, wherein, the examiner explicitly stated passages in the cited references which were not even addressed. The aforementioned assertion wherein all the limitations are not taught or suggested by the prior of record, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. The examiner has provided in the last office action, a convincing one of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the cited references. Applicants are reminded that 37 CFR 1.111(b) states, a general allegation that the claims define a patentable invention without specifically printing out how the language of the claims patentably distinguishes them from the references does

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not comply with the requirements of this section. Therefore, the applicants have failed to provide prima facie evidence how the language of the claims patentably distinguished them from the cited references. Hence, the applicants' assertions are just mere allegation with no supported fact. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Anh Ly /AL/

Patent Examiner GAU 2162

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Conferees:

/John Breene/

Supervisory Patent Examiner, Art Unit 2162

/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2169

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238